

REMARKS/ARGUMENTS

After entry of this paper, claims 50-55 are pending. Claims 1-49 are cancelled, without prejudice, in an effort to place the application in condition for allowance. Applicants reserve the right to pursue one or more of the cancelled claims in a divisional or continuation application.

Double Patenting Rejection

Claims 2-7, 9, 14, and 44-55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5, and 12 of US Patent No. 6,946,454 ('454) and 6,331,562 ('562).

The Examiner asserted that one of skill in the art would have been motivated to employ both compounds of '454 and that of '562 in a method of inducing contraception and that "...employing two agents which are known to be useful for contraception individually, in a method useful for the very same purpose is prima facie obvious".

Applicants respectfully request reconsideration and withdrawal of this rejection for the following reasons.

As the Examiner is aware, in determining whether a nonstatutory basis exists for a double patenting rejection, it is to be determined if any **claim** in the application, i.e., the present application, defines an invention that is merely an obvious variation of an invention claimed in the patent. Further, MPEP § 804 provides that "[d]omination and double patenting should not be confused".

Applicants agree that the claims of '454 recite methods of contraception using compounds that are a broad genus of the compounds encompassed by the claims of the present application with respect to the R¹-R⁵ substituents. However, in order for one to select the compounds encompassed by Applicants' claims, one would need to be motivated to select the following to provide the compounds claimed by Applicants:

- (i) not only a pyrrole, but a 2-cyanopyrrole at the 6-position whereby the N-atom is alkylated;

- (ii) S-atom at the 2-position;
- (iii) H-atom at the 1-position; and
- (iv) H-atoms at the 5-, 7-, 8-, and 9-positions.

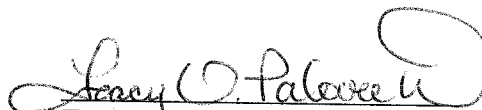
None of the claims of '454 or '562 specifically point to such compounds. Nor is there any motivation in '454 or '562 to select the specifically claimed compounds of the pending claims and then combine the same with selective estrogen receptor modulators. That motivation is ONLY provided by Applicants' specification.

Withdrawal of this rejection is requested.

The Director is hereby authorized to charge any deficiency in any fees due with the filing of this paper or during the pendency of this application, or credit any overpayment in any fees to our Deposit Account No. 08-3040.

Respectfully submitted,

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